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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/736,451

12/14/2003

Joshua D. Hug

109905-132844

3080

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03/15/2006

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EXAMINER

ZAND, KAMBIZ

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/736,451	<b>Applicant(s)</b> HUG ET AL.	
	<b>Examiner</b> Kambiz Zand	<b>Art Unit</b> 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.


#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
KAMBIZ ZAND  
PRIMARY EXAMINER

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/15/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. **Claims 1-42** have been examined.

#### ***Information Disclosure Statement PTO-1449***

2. The Information Disclosure Statement submitted by applicant on 11/15/2004 has been considered. Please see attached PTO-1449.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. **Claims 1-42** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 3-5, 20-21, 24-26 and 41-42 the "digital certificate contains unique identifiers" (emphasized added) phrases makes the claims indefinite and unclear in that neither method steps/means nor interrelationship of method steps/means are set forth in these claims in order to achieve the desired results expressed in the above phrases. In order to implement the above method steps, examiner suggests insertion of the phrase "of a

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plurality of unique identifiers” after the limitation “unique identifier” line 2 of claims 3, 20, 24 and 41.

5. **Claims 1, 2, 4, 5, 7, 8, 16, 17, 21-23, 25, 26, 37, 38 and 42** recites the limitation "the client" in the claim. There is insufficient antecedent basis for this limitation in the claim. Examiner would consider "the client device" for the purpose of examination. Examiner would consider any amendments to the claim that involves a client, user, etc. in addition to the limitation "client device" as changing the scope of the claims by introducing an extra utility in association with the utility "client device".

6. **Claims 3,6,9-15,18-20,24,27-36 and 39-41** are rejected based on their dependency on the above claims.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-42** are rejected under 35 U.S.C. 102(e) as being anticipated by Conrado et al (Privacy in an identity-based DRM system).

**As per claims 1 and 22** Conrado et al (Privacy in an identity-based DRM system) teach in a client device equipped with a digital rights management system (DRM) see 1. introduction, a method, a machine readable medium having stored thereon machine executable instructions comprising: receiving a digital certificate associating an arbitrary digital action with a selected one or more of a plurality of secure components to facilitate performance of the digital action on protected content by the client (see page 390 ieee (page 2 of the enclosed reference; function 1; or left column); verifying whether the digital certificate is authentic (see page 2 of the enclosed reference or page 390 of iEEE); determining whether the client is authorized to perform the digital action (see page 1 and 2 of the enclosed reference or page 389-390 ieee with respect to item 2. Identity based content); and performing the digital action via execution of the one or more secure components if the digital certificate is authentic and the client is authorized to perform the requested action (see page 2-7 of enclosed reference or page 390-3950.

**As per claims 2 and 23** Conrado et al (Privacy in an identity-based DRM system) teach the method, the machine readable medium of claims 1 and 22, wherein determining whether the client is authorized to perform the digital action comprises determining whether a rights object associated with the protected content authorizes performance of the requested digital action based upon a rights expression corresponding to the DRM

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(see page 2 of the enclosed reference or page 390 of IEEE).

**As per claims 3, 20, 24 and 41** Conrado et al (Privacy in an identity-based DRM system) teach the method, the machine readable medium of claims 1, 17, 22 and 38, wherein each of the selected one or more secure components is associated with a corresponding unique identifier and the digital certificate contains unique identifiers corresponding to each of the selected one or more secure components (see page 2 of the enclosed reference or page 390 of IEEE).

**As per claims 4 and 25** Claudine et al (Privacy in an identity-based DRM system) teach the method, the machine readable medium of claims 3 and 24, further comprising determining whether each of the selected one or more secure components are stored on the client (see page 2 of the enclosed reference or page 390 of IEEE).

**As per claims 5 and 26** Conrado et al (Privacy in an identity-based DRM system) teach the method, the machine readable medium of claims 4 and 25, further comprising dynamically obtaining those of the selected one or more secure components stored external to the client (see pages 2-4 of the enclosed reference or page 390-392 of IEEE).

**As per claims 6 and 27** Conrado et al (Privacy in an identity-based DRM system) teach the method, the machine readable medium of claims 1 and 22, wherein the digital

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certificate comprises a digital signature signed by a trusted third-party using a root encryption key belonging to a content provider source of the protected content (see page 2-6 of the enclosed reference or pages 390-395 of IEEE).

**As per claims 7 and 28** Conrado et al (Privacy in an identity-based DRM system) teach the method, the machine readable medium of claims 6 and 27, wherein verifying whether the digital certificate is authentic comprises the client validating the digital signature of the digital certificate (see page 2-6 of the enclosed reference or pages 390-395 of IEEE).

**As per claims 8 and 29** Conrado et al (Privacy in an identity-based DRM system) teach the method, the machine readable medium of claims 6 and 27, wherein the digital certificate is received in response to a request by the client to perform the digital action (see page 2-6 of the enclosed reference or pages 390-395 of IEEE).

**As per claims 9 and 30** Conrado et al (Privacy in an identity-based DRM system) teach the method, the machine readable medium of claims 8 and 29, wherein the digital action comprises a selected one of a transcoding of the secure content, and a transfer of the protected content to another device (see page 2-6 of the enclosed reference or pages 390-395 of IEEE).

**As per claims 10 and 31** Conrado et al (Privacy in an identity-based DRM system)

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teach the method, the machine readable medium of claims 1 and 22, wherein protected content comprises one or more content objects encrypted with components of a rights expression language of the DRM (see page 2-6 of the enclosed reference or pages 390-395 of IEEE).

**As per claims 11 and 32** Conrado et al (Privacy in an identity-based DRM system) teach the method, the machine readable medium of claims 10 and 31, wherein the DRM is implemented in tamper resistant code (see page 5, item 5.2 of the enclosed reference or page 394 of IEEE where examiner considers concealing RAN as corresponding to Applicant's tamper resistant code).

**As per claims 12 and 33** Claudine et al (Privacy in an identity-based DRM system) teach the method, the machine readable medium of claims 1 and 22, further comprising receiving a digital rights object generated by a rights issuer associated with the secure content (see page 2-6 of the enclosed reference or pages 390-395 of IEEE).

**As per claims 13, 19, 34 and 40** Conrado et al (Privacy in an identity-based DRM system) teach the method, the machine readable medium of claims 12, 18 and 39, wherein the digital rights object comprises a license (see page 2 of the enclosed reference or page 390 of IEEE where examiner considers attributes rights as corresponding to Applicant's license such as right or license for playback content on a certain device as an example on page 2 of the enclosed reference) .



**As per claims 14 and 35** Conrado et al (Privacy in an identity-based DRM system)

teach the method, the machine readable medium of claims 12 and 33, wherein the digital rights object is automatically received from the rights issuer (see page 2-6 of the enclosed reference or pages 390-395 of IEEE).

**As per claims 15 and 36** Conrado et al (Privacy in an identity-based DRM system)

teach the method, the machine readable medium of claims 12 and 33, wherein the digital rights object is received from the rights issuer in response to a user request (see page 2-6 of the enclosed reference or pages 390-395 of IEEE).

**As per claims 16 and 37** Conrado et al (Privacy in an identity-based DRM system)

teach the method, the machine readable medium of claims 15 and 36, wherein the user request is initiated via a user input device associated with the client (see page 2-6 of the enclosed reference or pages 390-395 of IEEE).

**As per claims 17 and 38** Conrado et al (Privacy in an identity-based DRM system)

teach a method a machine readable medium having stored thereon machine executable instructions comprising: generating a plurality of secure components to facilitate performance of one or more digital content related actions by a client device; generating a digitally signed certificate associating an arbitrary digital action with a selected one or more of the plurality of secure components; and providing the digital certificate to the

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client (see page 1-7 of the enclosed reference or pages 389-395 of IEEE).

**As per claims 18 and 39** Conrado et al (Privacy in an identity-based DRM system)

teach the method, the machine readable medium of claims 17 and 38, further comprising: generating a rights object corresponding to a digital rights management system (DRM) designed to facilitate performance of at least a subset of the one or more digital content related actions by the client device; and providing the rights object to the client device (see page 5-6 of the enclosed reference or pages 394-395 of IEEE).

**As per claims 21 and 42** Conrado et al (Privacy in an identity-based DRM system)

teach the method, the machine readable medium of claims 20 and 41, further comprising: providing the selected one or more of the plurality of secure components to the client (see page 2-6 of the enclosed reference or pages 390-395 of IEEE).

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Please see enclosed PTO-892 for related references and their contents.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned as (703) 872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KAMBIZ ZAND  
PRIMARY EXAMINER

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